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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/728,856   | 12/08/2003  | Byugjin Kim          | 2950-0277P                      | 9299                        |
| 2292 7590 07/13/2007<br>BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | EXAMINER<br>BOCCIO, VINCENT F   |                             |
|  |             |                      | ART UNIT<br>2165                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>07/13/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

Application No.

10/728,856

Applicant(s)

KIM ET AL.

Examiner

Vincent F. Boccio

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Amend. & Resp. of 4/4/07 3/6/07 VFB
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-11 and 13-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-11 and 13-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/435,608.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

Art Unit: 2165

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2165.

***Response to Arguments***

1. Applicant's arguments filed 4/4/07 have been fully considered but they are not persuasive.  
{A} In re page "This supplemental Amendment merely adds new claims 58-61 .... In view of the amendments and remarks of 3/6/07 it is believed the application is in condition for allowance.

Based on the arguments presented the 101 rejection is dropped. Also based on the arguments and amendments to the claims are also allowed over the prior art.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-2, 4-7, 9-11, 13-61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,470,135 and claims 1-28, of 6,925,247 in view of prior art Kikuchi (5,870,523, col. 21).

Although the conflicting claims are not identical, they are not patentably distinct from each other because.

Application claims 1-2, 4-7, 9-11 and 13-61  
Claims 1-2, 4-7 and 9, directed to a method of recording;  
Claims 10-11, 13-14, Apparatus for recording;  
Claims 15-18, directed to a method of recording;  
Claims 19-21, directed to a recording medium (data structure);  
Claims 22-25, directed to an apparatus for recording;  
Claims 26-35, directed to a method of recording;  
Claims 36-44, directed to a recording medium (data structure);  
Claims 45-54, directed to an apparatus for recording (means);  
Claims 55-61, directed to a method for recording.

Claims 1-2, 4-7, 9-11, 13-61, are distinguishable over the prior art in view of the independent claims reciting, wherein the "information indicates whether or not the entry point map exists independent of whether or not the object includes video data".

The prior art cover alls limitations except that the prior art provides the MAP having addresses (1) and indicators (2) being flags (one/1 or zero/0, states), which indicate existence or non-existence of video data corresponding to the address, but, there exist no suggestion to not record the MAP addresses, for video that does not exist or to only record addresses for which video exists.

The claims as understood are distinguishable in view of the address existence indicates video exist, while the prior art, records the address for all VOBUs and a Flag in addition to which indicates existence/not, VOBUs to indicate that they have video to process.

In effect the data structure is deemed novel in the light that less information is stored to perform substantially the same operation, saving space of addresses that point to areas that do not have video data to process.

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Entry point map comprises map information when the object includes video, but the map does not exist, when the object does not include video.

Kikuchi (5,870,523) col. 21, records, has recorded thereon a medium, reproduces the same, a medium having the MAP information, which includes addresses for VOBUs and a flag for each in the addresses in the map, the flags indicates, if the video exist corresponding to the address location in the map.

Patented claims of 6,470,135 in view of Kikucki as previously applied render obvious the claims of this application.

Patented claims of 6,470,135, comprise the limitation of not recording addresses for video object units which do not have video data (see claim 1 of 6,470,135), as recited,

- checking the existence and
- creating ... upon the checked result and
- creating and recording information indicating whether the information regarding the location exist or not.

All independent claims 1, 6, 10, 15, 19, 22, 26, 36, 45, 55 and 58 are deemed obvious over independent application claims.

Regarding dependent claims 2, 4-5, 7, 9, 11, 13-14, 16-18, 20-21, 23-25, 27-35, 37-44, 46-54, 56-57, 59-61 are rejected under obvious double patenting (ODP), for features deemed to be obvious in view of the prior art Kikucki etc. in combination with the patented claims, in view of Kikuchi, under an Obvious Double Patenting Rejection.

Since Kikucki was applied in a rejected in view of prior art, missing the one limitation, as defined above, the missing limitation, as disclosed/taught, by applicants patented claims, the application claims are rejected in view of the patented claims in view of Kikucki under above (ODP).

Therefore, it would have been obvious to further recite various features of Kikucki, as recited in the application claims, as is obvious to those skilled in the art at the time of the invention.

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The examiner also rejects application claims in view of {US 6,925,247} in view of {US 6,925,247} already being terminally disclaimed against {US 6,925,247} this is a logical link request (Requesting a Terminal Disclaimer against two patents identified).

Therefore, application claims are rejected over {US 6,470,135}, as applied above and further rejected against {US 6,470,135}, since linked to {US 6,925,247}, through a Terminal Disclaimer.

Allowance of claims of the instant application would result in a time-wise extension of the monopoly previously granted for the invention defined by patent claims of US 6,925,247 & US 6,470,135 therefore obviousness type double patenting is deemed proper.

**Contact Information**

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record Vincent F. Boccio whose telephone number is (571) 272-7373.

The examiner can normally be reached on between Monday thru Friday between (7:30 am to 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Primary Examiner, Boccio, Vincent  
7/7/07

  
VINCENT BOCCIO  
PRIMARY EXAMINER